

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-10 were pending in this application when last examined and stand rejected.

Claim 1 is amended to incorporate the subject matter of claim 8. Of course, claim 8 is now cancelled as being redundant to now amended claim 1.

Claims 2-7 and 9-10 have been amended, in a non-narrowing manner, to better conform to U.S. claim form. Such revisions are non-substantive and not intended to narrow the scope of protection. Such revisions include: replacing the "characterized by" language with "wherein"; revising the beginning of the claims to recite "A" or "The" and revising the claim language to provide proper antecedent basis throughout the claims; revising the claims to proper Markush format.

Further support for the amendment to claim 5 can be found in the disclosure, for example, at page 5, lines 4-10, line 16 and lines 20-21.

Claims 4 and 6 have been amended to remove the "such as" and "preferably" language, which limitations have been added back in new dependent claims 14 and 15.

Support for new claim 16 can be found in original claim 1.

No new matter has been added by the above claim amendments.

Claim 8 has been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claims 1-7, 9-10 and 14-16 are pending upon entry of this amendment.

Applicants note the amended claims do not present any new issues for consideration and/or search as they incorporate subject matter already considered by the Office. Accordingly, if the next Office Action on the merits includes a new rejection of one or more claims, the Action must be non-final.

Applicants are submitting the present Amendment without prejudice to the subsequent prosecution of claims to some or all of the subject matter which might be disclaimed by virtue of this response (although none is believed to be), and explicitly reserve the right to pursue some or all of such subject matter, in Divisional or Continuation Applications.

Applicants thank the Examiner for the careful examination of this case and respectfully request reexamination and reconsideration of the case, as amended. Below Applicants

address the rejections in the Office Action and explain why the rejections are not applicable to the pending claims as amended.

## II. INDEFINITENESS REJECTION

Claims 4-7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons in items 5-7 on pages 2-3 of the Office Action.

Applicants respectfully submit that the present Amendment overcomes this rejection. As noted above, Applicants have amended claims 4 and 6 to remove the "such as" and "preferably" language. Claim 5 has also been amended to clarify the language therein by specifying the various surfaces used.

The claims are thus clear, definite and have full antecedent basis. This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

## III. ANTICIPATION REJECTION

Claims 1, 3, 6, and 7 were rejected under 35 U.S.C. § 102(b) as anticipated by BRAUN (EP 0194770) for the reasons in items 10-12 on pages 3-4 of the Office Action.

This rejection is respectfully traversed.

It is well established that to anticipate a claim, a cited prior art reference must disclose or suggest each and every element of the claimed invention. See, M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2131.

In the instant case, amended claim 1 recites "hydrophilic polymeric material with silica particles dispersed in the aqueous medium." Applicants respectfully submit BRAUN fails to disclose or suggest this feature of amended claim 1.

BRAUN discloses disinfectant polymeric coatings for hard surfaces comprising a water-insoluble copolymer comprising hydrophilic functional groups. However, the disinfectant polymeric compositions disclosed in BRAUN do not comprise silica particles dispersed in the aqueous medium. The Examiner acknowledges this deficiency in BRAUN at item 17, on page 4 of the outstanding Office Action.

The rejection falls because BRAUN does not disclose each and every feature of claim 1. For this reason, claim 1 and all claims dependent thereon are novel over BRAUN. Thus, the above 102(b) rejection of claims 1, 3, 6 and 7 is untenable and should be withdrawn.

#### IV. OBVIOUSNESS REJECTION

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being obvious over BRAUN in view of STOVICEK (US 4,990,547) for the reasons in items 15-19 on pages 4-6 of the Office Action.

This rejection is respectfully traversed.

It is well established that to support a *prima facie* case of obviousness, the Office must provide a rationale showing that all the claimed elements were known in the prior art and one

skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions to yield predictable results. See, *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 U.S.P.Q.2d 1385, 1395 (2007); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.02.

As discussed above, BRAUN fails to disclose or suggest the "hydrophilic polymeric material with silica particles dispersed in the aqueous medium" of claim 1. Applicants respectfully submit STOVICEK fails to remedy this deficiency.

According to the Office, one skilled in the art would have been encouraged to include silica particles as in STOVICEK in the polymeric compositions disclosed by BRAUN. Applicants respectfully disagree.

It must be noted that STOVICEK teaches coating compositions that are specifically designed for antifouling, that are useful, notably for coating fish netting, boat hulls, lumber, roof shingles and the like to prevent the growth of algae or fungi. Thus, the coating compositions disclosed in STOVICEK are specifically designed for reducing contamination of surface areas by marine organisms.

This is why the coating compositions taught by STOVICEK essentially comprise an emulsion polymer and a non-metallic algicid that does not react with the polymer. As algicid agents, STOVICEK essentially or exclusively discloses quaternary

ammonium compounds (see column 2, lines 18-40; column 2, line 60 to column 3, line 63).

As disclosed in column 2, line 57 to column 3, line 2, the emulsion polymer of the compositions by STOVICEK must be at least partly cross-linked. As explained by STOVICEK, the at least partly cross-linked polymers are important since they allow to encapsulate the algicid active ingredients, namely the quaternary ammonium compounds.

Additionally, when very large amounts of quaternary ammonium compounds are designed in the compositions, then the use of fillers like precipitated silica is useful (see column 2, lines 62-64). The function of the filler consists of absorbing the quaternary ammonium on the filler surface (see column 4, lines 3-6). Consequently, it flows from the teachings of STOVICEK that the addition of a filler to the polymeric composition may be performed exclusively for the purpose of absorbing a quaternary ammonium compound algicid active ingredient.

Because the compositions taught by BRAUN do not comprise any algicid active ingredient, one skilled in the art would have found no reason to add a filler agent like precipitated silica to the compositions disclosed by BRAUN.

Further, even if one skilled in the art had combined the teachings of STOVICEK with those of BRAUN, then he would have arrived at a composition of the type disclosed by STOVICEK, wherein it would have been added a combination of an algicid

active ingredient and precipitated silica, since the teachings of STOVICEK are that precipitated silica addition is exclusively motivated when algicid quaternary ammonium compounds are present, in view of absorbing them and delay their release.

It follows then that the combination of BRAUN and STOVICEK cannot render obvious the claimed method.

Also, it should be noted that the "consisting of" format of independent claim 1 excludes the combination with an algicid active ingredient as in STOVICEK.

For these reasons, Applicants respectfully submit that the combination of BRAUN and STOVICEK fail to render obvious independent claim 1 and all claims dependent thereon.

Therefore, Applicants respectfully submit that the above-noted 103(a) obviousness rejection over BRAUN and STOVICEK is untenable and should be withdrawn.

#### V. CONCLUSION

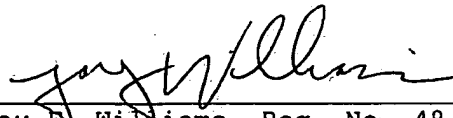
In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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